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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/493,803 01/28/00 60000

A ABZ-002

000959  
LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON MA 02109

HM22/0721

EXAMINER

KRLISE, D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED:

07/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/493,803	GOOD, ALLEN G.
	Examiner	Art Unit
	David H Kruse	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 0 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims 1-63 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - a) All b) Some \* c) None of the CERTIFIED copies of the priority documents have been:
    1. received.
    2. received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
    3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

#### Attachment(s)

15) <input type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	20) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a method of plant transformation with a brassica turgor gene-26 promoter element, classified in class 800, subclass 287, for example.
  - II. Claims 5,6,25,34,35 and 36, drawn to a method for fruit-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
  - III. Claims 7,8,26,37,38 and 39, drawn to a method for root-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
  - IV. Claims 9,10,27,40,41 and 42, drawn to a method for seed-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
  - V. Claims 11,12,28,43,44 and 45, drawn to a method for flower-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
  - VI. Claims 13,14,29,46,47 and 48, drawn to a method for tuber-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.

- VII. Claims 15,16,30,49,50 and 51, drawn to a method for shoot-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
- VIII. Claims 17,18,31,52,53 and 54, drawn to a method for vascular-specific expression, and seed produced by said method m, classified in class 800, subclass 298, for example.
- IX. Claims 19,20,32,55,56 and 57, drawn to a method for meristem-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
- X. Claims 21,22,33,58,59 and 60, drawn to a method for pollen-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.
- XI. Claims 23,24,34,61,62 and 63, drawn to a method for ovule-specific expression, and seed produced by said method, classified in class 800, subclass 298, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to methods of expression within different tissues with different tissue-specific regulatory elements. Invention I is drawn to a method for tissue-specific expression with a brassica turgor gene-26 promoter

element and is particularly limited to tissue-specific expression in the root or leaves of a plant. Examination of Invention I requires prior art searches and gene sequence searches not required for the other Inventions. Invention II is drawn to a method for fruit-specific expression in plants and to seed produced by said method. Examination of Invention II would require prior art search and consideration of fruit-specific regulatory elements, which would not be required for examination of the other Inventions. Invention III is drawn to a method for root-specific expression in plants and to seed produced by said method. Examination of Invention III would require prior art search and consideration of root-specific regulatory elements, which would not be required for examination of the other Inventions. Invention IV is drawn to a method for a seed-specific expression in plants and to seed produced by said method. Examination of Invention IV would require prior art search and consideration of seed-specific regulatory elements, which would not be required for examination of the other Inventions. Invention V is drawn to a method for a flower-specific expression in plants and to seed produced by said method. Examination of Invention V would require prior art search and consideration of flower-specific regulatory elements, which would not be required for examination of the other Inventions. Invention VI is drawn to a method for a tuber-specific expression in plants and to seed produced by said method. Examination of Invention VI would require prior art search and consideration of tuber-specific regulatory elements, which would not be required for examination of the other Inventions. Invention VII is drawn to a method for a shoot-specific expression in plants and to seed produced by said method. Examination of Invention VII would require prior art search and

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consideration of shoot-specific regulatory elements, which would not be required for examination of the other Inventions. Invention VIII is drawn to a method for a vascular-specific expression in plants and to seed produced by said method. Examination of Invention VIII would require prior art search and consideration of vascular-specific regulatory elements, which would not be required for examination of the other Inventions. Invention IX is drawn to a method for a meristem-specific expression in plants and to seed produced by said method. Examination of Invention IX would require prior art search and consideration of meristem-specific regulatory elements, which would not be required for examination of the other Inventions. Invention X is drawn to a method for a pollen-specific expression in plants and to seed produced by said method. Examination of Invention X would require prior art search and consideration of pollen-specific regulatory elements, which would not be required for examination of the other Inventions. Invention XI is drawn to a method for an ovule-specific expression in plants and to seed produced by said method. Examination of Invention XI would require prior art search and consideration of ovule-specific regulatory elements, which would not be required for examination of the other Inventions.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete within 30 days must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Paula Hutzell can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1234.



**AMY J. NELSON, PH.D  
PRIMARY EXAMINER**

David H. Kruse, Ph.D.  
21 July, 2000